

U.S.S.N. 08/445,805

Page 2

anticipated by or obvious over the issued patent alone or in combination with any other reference under 35 USC §102 or 35 USC §103.

In view of the enclosed Terminal Disclaimer and accompanying Certificate under 37 CFR §3.73(b), applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, 7-8, 10, and 15-17 under the judicially created doctrine of obviousness-type double patenting.

On page 2 of the Office Action, claims 1-17 are rejected under 35 USC §112, first paragraph, as the disclosure is allegedly enabling only for claims limited to specific renal disorders, AIDS-related cachexia, head-injured patients who presented with hypercatabolism and nitrogen loss, and diabetes. However, on page 3 of the Office Action it is stated that claims 1-5 and 7-17 would be allowable upon filing a Terminal Disclaimer, and that claim 6 was not enabled. Since these two statements are conflicting, the undersigned attorney called the Examiner to obtain an explanation. After reviewing the file Examiner Touzeau offered the explanation, by telephone on May 27, 1997, that claims 1-5 and 7-17 would be allowable upon filing a Terminal Disclaimer but that claim 6 is not enabled. The undersigned attorney pointed out the apparent contradictory statement on page 2 of the Office Action indicating that claims 1-17 were rejected for lack of enablement, but was not provided with a clear explanation as to how these conflicting statements can be reconciled, and there was no offer to provide a re-issued Office Action clarifying this issue.

Applicants hereby request clarification of the record of the above-identified application to indicate the exact claims subject to the 35 USC §112, first paragraph rejection so that applicants can properly respond.

Finally, applicants attach a copy of an initialed PTO-1449 form from the PTO that lacks the Examiner's initials on the last

U.S.S.N. 08/445,805

Page 3

reference 70 (Webb et al.). Applicants respectfully request that the Examiner provide her initials next to this last reference so that it will be indicated officially as having been considered and will be entered on the face of the patent.

Respectfully submitted,
GENENTECH, INC.

Date: June 2, 1997By: Janet E. Hasak
Janet E. Hasak
Reg. No. 28,616

460 Pt. San Bruno Blvd.
So. San Francisco, CA 94080-4990
Phone: (415) 225-1896
Fax: (415) 952-9881